

REMARKS

The Office Action mailed April 17, 2009, has been received and carefully considered. Claims 5-8 have been cancelled, claims 9-12 have been amended, and new claims 13-16 have been added. A new Abstract has been added. To the best of the undersigned attorney's information and belief, these changes contain no new matter for the reasons given in the remarks which follow.

Claims 9-16 are pending in the Application and are submitted to be in allowable condition. Claims 9 and 13 are independent.

Claim Changes and Support

Independent claim 9 has been amended to limit this claim to the embodiment in which "Y represents a sulfur atom", so that support is believed clear.

The dependency of claims 10-12 has been changed to depend ultimately from claim 9.

New independent claim 13 finds support in claim 9 and limits this claim to the embodiment in which "Y represents an oxygen atom", so that support is believed clear.

New claims 14-16 find support in claims 10-12.

The rejection of claims 5-12 under 35 U.S.C. §103(a) as unpatentably obvious over Kobayashi (GB 2,349,388) in view of Nambe (US 5,506,357) is moot regarding cancelled claims 5-8 and is respectfully traversed regarding claims 9-12 as amended, as well as regarding new claims 13-16.

1. Applicants note that Kobayashi et al. is Applicants' earlier Application that was brought to the U.S. Examiner's attention in an Information Disclosure Statement filed June 15, 2007. Clearly Applicants consider that the present invention is novel, useful, and unobvious over Applicants' prior disclosure for the reasons given in the following.

2. The Examiner points out that Kobayashi et al. discloses a blue color filter containing a first colorant (see page 5, the "first cyanine dye" of formula (1) with a ClO₄⁻ anion), a binder resin (see page 7, paragraph 1, "photosensitive resin"), and a second colorant (see page 6, the

"second cyanine dye" of formula (2)).

3. The Examiner acknowledges that that the second colorant of Kobayashi et al. differs from that of Applicants' formula (2) in that Kobayashi et al. disclose only alky substitution in the Y-position while the Y-position of Applicants' formula (2) is occupied by an oxygen atom (claim 13) or a sulfur atom (claim 9). The Examiner therefore relies on the disclosure of Nambe where structures (4) and (5) represent cyanine dyes with a sulfur atom at the Y-position. The Examiner has not mentioned structures in Nambe where cyanine dyes with an oxygen atom at the Y-position, but it appears that Nambe does disclose such structures (see, for example, claim 1, Col. 41, line 30, and Col. 43, line 30).

4. The Examiner justifies this combination on page 4 of the Action as a mere substitution of one cyanine dye for another with a reasonable expectation of success because (a) one would expect that cyanine dyes would behave in a similar fashion or (b) analogous dye structures have that type of substitution. The Examiner acknowledges that the disclosure of Nambe is in a different field of endeavor because the use of the dye is different, but argues that a chemist would look for analogous dye structures using a structure search.

5. Further, the Examiner acknowledges that Kobayashi et al. do not mention the anions used for the second colorant. The Examiner therefore relies on the disclosure of Nambe (see Col. 4, lines 7-8).

6. Contrary to the Examiner's positions, Applicants respectfully submit that one of ordinary skill in this art would not consider the cyanine dyes of Nambe as "mere substitutes" for the second cyanine dye of Kobayashi et al. because the artisan would not expect the cyanine dyes of Nambe to have similar properties when used according to the present invention, e.g., due to the steric hinderance of the substituted carbon in the Y-position of the second colorant of Kobayashi et al. compared to the unsubstituted Y-position when Y is a sulfur atom or an oxygen atom.

7. Thus, Applicants traverse the Examiner's rationale for combining these disclosures where, as here, (1) stereochemistry would differ for these heterocyclic structures so that an artisan would not expect similar properties and would - in fact - expect different properties, and (2) the cyanine dyes of Nambe are used in a different field of endeavor, i.e., in optical recording medium.

8. In view of the foregoing distinction, Applicants respectfully submit that no *prima facie* case of obviousness has been made out regarding claims 9-12, and new claims 13-16 for analogous reasons, so that this ground of rejection should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that claims 9-16 and the Application are in condition for allowance. Reconsideration and passage of this case to issue are therefore requested.

Should the Examiner consider that a conference would help to expedite the prosecution of this Application, the Examiner is invited to contact the undersigned to arrange for such an interview.

No fee is believed due. If any fee is deemed due, the Commissioner is hereby authorized to charge the same to our Deposit Account No, 18-0002 and is requested to advise us accordingly.

Respectfully submitted,



Steven M. Rabin. (Reg. No. 29, 102)
Rabin and Berdo PC
CUSTOMER NO. 23995
1101 - 14th Street, N.W., Suite 500
Washington, D.C. 20005
Tel.: (202) 371-8976
Fax: (202) 408-0924

SMR/AJW:ac